

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

ARNAUD et al

Serial No. **09/049,927**

Filed: **March 30, 1998**

Title: **ANHYDROUS COSMETIC OR DERMATOLOGICAL
COMPOSITION....**

Assistant Commissioner for Patents
Washington, DC 20231

Atty Dkt. **2350-60**

C#/M#

Group Art Unit: **1612**

Examiner: **Huang**

Date: **October 14, 1999**



RECEIVED

OCT 15 1999

Sir:

TECH CENTER 1600/2900

RESPONSE

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Fees are attached as calculated below:

Total effective claims after amendment	0	minus highest number	
previously paid for	20	(at least 20) =	0 x \$ 18.00
			\$ 0.00

Independent claims after amendment	0	minus highest number	
previously paid for	3	(at least 3) =	0 x \$ 78.00
			\$ 0.00

If proper multiple dependent claims now added for first time, add \$260.00 (ignore improper)	\$ 0.00
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Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$ 110.00 /1 month; \$380.00/2 months; \$870.00/3 months)	\$ 0.00
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Terminal disclaimer enclosed, add \$110.00	\$ 0.00
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First submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$760.00)	\$ 0.00
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Second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$760.00)	\$ 0.00
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☐ Please enter the previously unentered filed

SUBTOTAL \$ 0.00

If "small entity," then enter half (1/2) of subtotal and subtract	-\$ 0.00
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☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$240.00)	\$ 0.00
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Assignment Recording Fee (\$40.00)	\$ 0.00
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TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYTE P.C.
By Atty: B.J. Sadoff, Reg. No. 36,663

Signature: _____

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In re PATENT APPLICATION OF
ARNAUD et al.

Atty. Ref.: 2350-60

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For: ANHYDROUS COSMETIC OR DERMATOLOGICAL
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#12095
3/10/99
11-20-99

Assistant Commissioner of Patents
Washington, DC 20231

RESPONSE

Sir:

Responsive to the Office Action dated July 14, 1999, entry and consideration of the following remarks are requested.

The applicants acknowledge, with appreciation, the Examiner interview of October 13, 1999. The Examiner Interview Summary Record is accurate in its brief description of the issues discussed.

Claims 13-37 are pending.

The Section 112, first paragraph, rejection of claims 13-37 is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following remarks.

As explained to the Examiner during the interview, the presently claimed invention is directed to a solid silicone composition comprising components (a) and (b). The present specification provides, for example, solid silicone composition comprising components (a) and

(b), as required by the claims. See, examples 3-5 on pages 13-15 of the present specification.

The claims therefore, to a solid composition are supported by the present specification.

The Examiner's comparison of the present specification to the disclosure and claims of Stepniewski (U.S. Patent No. 5,648,066) for the purpose of alleging failures in the present specification is inappropriate. The applicants respectfully submit the claims are enabled by the present specification. The fact that oil gel agents or other components may be included in the compositions of the present disclosure does not support the Examiner's assertion that the present specification "teaches away from Stepniewski's invention". See, page 3 of the Office Action dated July 14, 1999 (Paper No. 10). As noted above, it is inappropriate for the Examiner to review the enablement provided by the present specification based on teachings of Stepniewski.

Moreover, Stepniewski teaches that emollients and occlusive agents, such as oils, hydrocarbons, fatty alcohols, fatty acids, ethers and sterols may be included in his composition. See, column 4, lines 50-65. In fact, Stepniewski's lipstick composition of example 4 includes jojoba oil as well as other additive and charges which are described as being potential additives in column 5, lines 1-30 of Stepniewski. Finally, the applicants note Stepniewski's claim 20 allows for up to 75% by weight of non-silicone fluid oil.

The applicants submit the present claims are support by an enabling disclosure and withdrawal of the Section 112, first paragraph rejection of claims 13-37 is requested.

The Section 103 rejection of claims 13-37 over Yoshioka (U.S. Patent No. 4,990,561) is traversed. Reconsideration and withdrawal of the rejection is requested in view of the following distinguishing remarks as well as the previously submitted copies of Mr. Stepniewski's

Declarations of June 20, 1996 and December 17, 1996, as found in the file history of U.S. Patent No. 5,648,066.

The applicants respectfully submit the polymerized composition of Yoshioka would not have made the presently claimed mixture of components obvious to one of ordinary skill in the art. That is, Yoshioka discloses a wax composition which is obtained by carrying out a polymerization reaction of a mixture of at least one macromonomer selected from a methylpolysiloxane (meth)acrylate macromonomers containing one (meth)acryl group and three or more methylsiloxy groups in a molecule with one or more of a vinylic polymerizable monomer(s) which is to "polymerize" with the macromonomers using a radical producing agent in the presence of both a polysiloxane component (dimethylpolysiloxane and/or methylphenylpolysiloxane) and an organic wax. The applicants respectfully submit that even if the organic wax can be synthetic polyethylene wax (as is one of the many waxes described in column 2, lines 55 to column 3, line 2 of Yoshioka), it would have been clear to one of ordinary skill in the art that the polymerization process described by Yoshioka would produce an end product different and distinct from the mere mixture of polyethylene together with a non-volatile silicone fluid, as are used in the presently claimed invention. One of ordinary skill in the art reading Yoshioka would not have simply mixed polyethylene and a non-volatile silicone fluid, without polymerization, to produce the presently claimed invention. Withdrawal of the Section 103 rejection of claims 13-37 over Yoshioka is requested.

As noted to the Examiner during the interview, the presently claimed invention has been found to be patentable over Yoshioka by Examiner Glass during prosecution of Application No. 08/538,550, which issued as U.S. Patent No. 5,648,066. The present Examiner's position that


the claims are not patentable over Yoshioka is contrary to the Patent Office issuance of these claims in U.S. Patent No. 5,648,066. The applicants demonstrated during the prosecution of Application No. 08/538,550, that these claims were patentable based on declaration evidence which has been previously submitted to the Examiner, and which is part of the public record. The present applicants, while not believing they necessarily need to rely on this declaration evidence, should be allowed to demonstrate the patentability of these claims based on this previously submitted evidence.

Withdrawal of the Section 103 rejection of claims 13-17 over Yoshioka (U.S. Patent No. 4,990,561) is requested.

In view of the above, the claims are submitted to be in condition for allowance and a Notice to that effect is requested.

Respectfully submitted,

NIXON & VANDERHYE, P.C.

By: 
B.J. Sadoff
Reg. No. 36,663

BJS:rdw
Attachment

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